

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Keene	CONFIRMATION NO.	8878
SERIAL NUMBER:	10/597,990	ART UNIT:	3753
FILING DATE:	August 15, 2006	EXAMINER:	Fox, John C.
TITLE:	Combination Flow Through Injection and Isolation Valve For High Pressure Fluids		

Pre-Appeal Brief Request for Review

Sir:

This paper responds to the final Office Action mailed from the United States Patent and Trademark Office on January 20, 2010. A petition for a three-month extension of time to extend the time of response up to and including July 20, 2010 was filed on July 14, 2010. A Notice of Appeal is filed concurrently herewith.

Appellant hereby submits that the final Office Action mailed on January 20, 2010 includes errors in the Examiner's rejections, and respectfully requests withdrawal of the rejection of claims 1 and 5-7 under 35 U.S.C. 112, first paragraph. Specifically, the Examiner did not construe the claims before performing an analysis of enablement under 35 U.S.C. 112, first paragraph, which is improper under the Manual of Patent Examining Procedure (M.P.E.P.) at Section 2164.04. Further, during analysis of enablement under 35 U.S.C. 112, first paragraph, the Examiner did not provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure, which is also improper under the M.P.E.P. at Section 2164.04.

I. Summary of Invention

Appellant's invention as recited in independent claim 1 features a flow through injection valve 850 (see, for example, Figure 4B and paragraph [0071]). The flow through injection valve 850 comprises a stationary member e.g., 802', and a movable member e.g., 804'. A surface of the stationary member 802 interfaces with a surface of said movable member 804, e.g., at interface 810'. The flow through injection valve 850 further comprises at least one pin valve e.g., 3, having a flow through an internal conduit e.g., 58'. The pin valve 3 is movably disposed so that the internal conduit 58' is capable of fluidically communicating with at least one flow through conduit e.g., 890', in the movable member 804'. The pin valve 3 is movably disposed so that the internal conduit 58' is capable of fluidically communicating with another flow through conduit, e.g., 886', in said movable member 804' (see, for example, Figure 4B and paragraph [0081]).

II. Issues

Whether claims 1 and 5-7 are improperly rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.

III. Arguments

Appellant submits that before any analysis of enablement can occur, it is necessary for the Examiner to construe the claims. Further, during analysis, the Examiner has the burden of providing a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure even when there is no evidence of operability without undue experimentation beyond the disclosed embodiments. In doing so, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.

In this case, the Examiner at page 3 of the final Office Action makes general assertions that the specification fails to enablingly disclose an operable valve, a pin valve, or flow paths. However, the final Office Action provides no indication as to whether the Examiner construed the claims prior to an analysis of enablement. For example, the Examiner asserts that the specification fails to enablingly disclose flow paths. However, flow paths are not claimed by Appellant. Thus, the Examiner here has not provided a reasonable explanation as to why the scope of protection provided by the claims is not adequately enabled by the disclosure.

Moreover, the final Office Action does not identify missing information and why one skilled in the art could not supply the information without undue experimentation. Rather, the Examiner takes a broad brush approach in attempting to describe why the specification is non-enabling. The only evidence provided is the Examiner's reliance on his 26+ years of experience of successfully understanding other patent applications. Appellant submits that this is an insufficient explanation as to why one skilled in the art could not supply missing information without undue experimentation.

In addition, Appellant submits that, contrary to the final Office Action, the disclosure as filed satisfies the requirement of enablement set forth under 35 U.S.C. 112, first paragraph and the M.P.E.P. at Section 2164.01, namely, that one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. In support of Appellant's position, Appellant refer to Figure 4B and corresponding details at paragraphs [0062]-[0082] of the specification as filed.

IV. Conclusion

In view of the foregoing remarks, Appellant submits that the rejection of claims 1 and 5-7 under 35 U.S.C. 112, first paragraph, is improper.

Withdrawal of the rejection of claims 1 and 5-7 is therefore respectfully requested.

In connection with this matter, please charge any otherwise unpaid fees which may be due, or credit any overpayment, to Deposit Account Number 50-2295.

Respectfully submitted,

Date: July 20, 2010
Reg. No. 58,037

Tel. No.: (508) 303-2003
Fax No.: (508) 303-0005

/Timothy P. Collins/
Timothy P. Collins
Attorney for Appellant
Guerin & Rodriguez, LLP
5 Mount Royal Avenue
Marlborough, MA 01752

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) W-359-02 (WAT-005US)			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10597990	Filed 08-15-2006			
	First Named Inventor Keene				
	Art Unit 3753	Examiner Fox, John C.			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>58037</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; border-left: 1px solid black; padding-left: 10px;"><p>_____ /Timothy P. Collins/ Signature</p><p>_____ Timothy P. Collins Typed or printed name</p><p>_____ 508-303-2003 Telephone number</p><p>_____ July 20, 2010 Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>58037</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p>_____ /Timothy P. Collins/ Signature</p> <p>_____ Timothy P. Collins Typed or printed name</p> <p>_____ 508-303-2003 Telephone number</p> <p>_____ July 20, 2010 Date</p>
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.					

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